

**PATENT EXAMINER
REISSUE APPLICATION CHECKLIST**

8/3/04

Examiner: NICHOLAS PONOMARENKO
Art Unit : 2834
Reissue Appl. No.: 10, 039, 819

THIS CHECKLIST IS PROVIDED AS AN AID TO THE REISSUE EXAMINATION PROCESS. IT SHOULD BE USED THROUGHOUT PROSECUTION AND MUST BE REMOVED FROM THE FILE AT THE TIME OF ALLOWANCE AFTER APPROVAL BY THE SPRE.

Reissue applications are considered "SPECIAL" (MPEP § 1442). Any reissue application appearing on an examiner's docket report should be taken up for action as the next new or amended case, even before other special applications.

Prior to examining a reissue application, the examiner should obtain and review the original patent file (MPEP § 1440). Examination of the reissue application is frequently directly linked to the prosecution history of the original application.

ALL CLAIMS ARE SUBJECT TO A FULL EXAMINATION ON THE MERITS, INCLUDING THE ORIGINAL CLAIMS OF THE PATENT, WHICH ARE BEING SURRENDERED IN THIS REISSUE APPLICATION.

Examiner: Complete items 1-20 prior to completing a first action. **Then, take the reissue application (and patented file, if available) to the SPRE for review, before mailing the action.**

_____(SPRE. initials) SPRE has reviewed before first action.

Complete items 21-22 when preparing the reissue application for allowance. SPRE must initial the file wrapper at the time of review for allowance.

A "Reissue Guide" containing a further explanation of each of the items on the checklist is available in paper form or electronically (by e-mail) from the Technology Center SPRE or Paralegal.

Indicate that each of the applicable items set forth below has been thoroughly reviewed with respect to the above-identified reissue application by answering YES, NO, or N/A to the following questions. The examiner should be able to answer "YES" to most of the questions. A "NO" answer may require some immediate action at that point or reference to the "Reissue Guide" for further explanation. See TC SPRE for further assistance, if needed.

- YES 1. **Has the original patent file wrapper been obtained and reviewed?** *If NO, see "Reissue Guide" for further assistance.*
- YES 2. **Is the (original) patent still in force, i.e., has not expired due to the conclusion of its term or due to the non-payment of the scheduled maintenance fees?** *A reissue application must actually issue as a reissue patent before expiration of the original patent. Accordingly, always make sure the patent will not expire during prosecution of the reissue application. See "Reissue Guide" for methods of checking patent term.*
- YES 3. **Has notice of the filing of the reissue application been published in the Official Gazette (O.G.)?** *If NO, STOP action and have your TC Paralegal forward the application to OIPE to effect publication. Reissue CPAs will not be announced in the O.G.*
- YES 4. **Is the current date more than two months after the O.G. publication date?** *If NO, wait until the two-month period has expired before preparing and issuing an Office action.. Continuation/divisional reissues may be acted upon before the expiration of the two-month period.*
- YES 5. **Has the file been reviewed for the presence of any protests under 37 CFR 1.291(a)?** *Protests may be filed during the two-month period following the O.G. notice, or anytime up until the Notice of Allowance, and should be considered in the next Office action, if in the file. See "Reissue Guide" for instructions on handling protests.*
- YES 6. **Is the reissue application a division or a continuation of another pending reissue application, or is there a child reissue application that is a division or continuation of this application?** *See In re Graff, 42 USPQ2d 1471. If YES, special handling as per "Reissue Guide" is required. See Item 19 below for restriction practice.*
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- NO 7. **Is the patent or the reissue application involved in litigation?** *Information may be found in file or requested from STIC. If YES, shortened reply periods may have to be set by the Examiner, or prosecution may have to be suspended. See "Reissue Guide." If NO, proceed with examination.*
- NO 8. **If the reissue application has been assigned, does it include the written consent to the filing by all of the assignees (37 CFR 1.172(a))?** *See MPEP § 1410.01. If NO, and a petition for a waiver of this requirement has been granted, the assent may be deferred until the case is otherwise allowable.*

- NO 9. **Have all documents (in applications filed on or after September 24, 1992) signed by, or on behalf of, the assignee(s) been checked and found to comply with the provisions of 37 CFR § 3.73(b)?** *This includes "consent" in No. 8, above. If NO, the statement under § 3.73(b) must be required before allowance.*
- YES 10. **Were any changes made to the patent by a Certificate of Correction dated prior to the filing of the reissue?** *If YES, check to see if the changes were properly entered as though part of the original patent, i.e., no brackets or underlining.*
- YES 11. **Has the application been reviewed for the presence of any errors, including any not specifically identified, which are not correctable by reissue?** *Reissue doesn't cure all patent ills. See "Reissue Guide" for listing of some errors which cannot be corrected by reissue.*
- YES 12. **Are any claims broader in scope (in ANY respect) than the original patent claims?** *If YES, note 35 USC 251, 3rd and 4th paragraphs. If NO, proceed to item 14.*
- NO 13. **Does the broadening (from Item 12) attempt to "recapture" any claimed subject matter which was deliberately added, or argued, to overcome a rejection in the original application?** *See "Reissue Guide" for explanation of "recapture doctrine." Subject matter deliberately surrendered may not be recaptured (reclaimed) in a reissue application.*
- NO 14. **Has: (1) the original patent been surrendered OR (2) does the application contain a statement that the original patent is lost or misplaced?** *If NO, the application cannot be allowed until either (1) or (2) is obtained.*
- NO 15. **Does the reissue application seek to provoke an interference with another patent?** *If NO, proceed to Item 17. If YES, see "Reissue Guide."*
- NO 16. **Do the issues of interference estoppel and the "lost count" doctrine apply?** *Applies to losing party of an interference. See "Reissue Guide."*
- YES 17. **Does the application include drawings (copies or originals) which meet the requirements of 37 CFR 1.84?** *If YES, be sure there are no amendments or additions to the original figures. Transfer of the drawings from the patent file will no longer be made by the Office.*

NO 18. **Does the reissue oath or declaration comply with all of the requirements of 37 CFR § 1.63 and 37 CFR § 1.175?** *See list of requirements in "Reissue Guide." If NO, reject under 35 U.S.C. 251 (citing relevant portion of 37 CFR 1.63 or 1.175).*

YES 19. **Does the reissue application contain claims to more than one invention?** 37 CFR 1.176. *If yes, and the several inventions were claimed in the patent, a restriction requirement dividing the several inventions cannot be made in the reissue. If added claims in the reissue are drawn to an invention not previously claimed, a restriction is possible. See Reissue Guide.*

NO 20. **Is the original patent currently involved in a reexamination proceeding?** *To determine this, check "Continuity" in PALM for the original patent number. If YES, forward all related files (including any reexam or reissue directed to the original patent) to the Office of Patent Legal Administration (OPLA) for consideration of a merger of the proceedings.*

THE FOLLOWING QUESTIONS SHOULD BE COMPLETED WHEN PREPARING THE APPLICATION FOR ALLOWANCE:

___ 21. **Have all amendments to the specification, drawings and claims been reviewed for compliance with 37 CFR § 1.173(b)?** *See amendment practice described in "Reissue Guide." If NO, amendment in accordance with § 1.173(b) will be required.*

___ 22. **The following items should be verified at the time of Allowance:**

___ a. None of the original patent claims have been renumbered.

___ b. Final numbering of claims added by reissue must follow the number of the highest numbered patent claim.

___ c. The claim selected for printing is one which was added or amended during reissue - never a canceled claim. (Where no claim is amended/added, print the same claim printed in the original patent).

___ d. On the inside left flap of the file-wrapper, the final claim numbering must be filled in properly. A canceled patented claim retains its original number although not considered in the total number of claims allowed. Therefore, on the face of the file-wrapper, the number in the box designated "Total Claims" under "CLAIMS ALLOWED" may be less than the highest number of the last allowed claim.

___ e. The original patent number must be placed on the file wrapper face after the examiner's initials following "Surrender of Original Patent" (for 09/ series) applications, or on the Issue Classification (Blue) Slip in the block below the applicant's name (for 08/ or earlier series applications).

- ____ f. Any Examiner's Amendment which makes changes to the patent which are substantive in nature may necessitate a supplemental reissue oath/declaration from applicant.
- ____ g. Classification and cross referencing on the file wrapper face (for 09/ series applications) or on the Issue Classification (Blue) Slip (for 08/ or earlier series applications) should include at least those classes and subclasses designated on the original patent. If a reclassification prevents use of the same class/subclasses, the new class/subclasses should be used. Call Patent Index (305-5227) to ascertain the new class/subclasses.
- ____ h. Terminal Disclaimer (TD) information has been placed on the file wrapper face for TDs filed either in the original patent or in the reissue application.
- ____ i. The references cited in the original patent have been cited in the reissue application on a Form PTO-892 or PTO-1449.
- ____ j. For any error corrected, which is not covered by an oath or declaration, i.e., any error corrected after the filing of all declarations currently in the reissue application, applicant **MUST** submit a supplemental oath or declaration prior to allowance stating "*[T]hat every such error arose without any deceptive intention on the part of the applicant*" (37 CFR 1.175(b)(1)), or language equivalent thereto. See MPEP 1444 for handling supplemental oaths/declarations.

Each allowed reissue application, together with the original patented file, is submitted to the TC SPRE for review prior to being released from the Technology Center. The box provided for "FINAL SPRE REVIEW" on the face of the gold and white reissue file wrappers is to be initialed by the TC SPRE. Once the reissue has been approved and revised for issue, the files should be sent to the Office of Patent Legal Administration.

This checklist is to be removed from the file by the SPRE at the time of final review.

All reissue applications are screened by the Office of Patent Legal Administration (OPLA) and may be reviewed by the Office of Patent Quality Review (OPQR) after allowance.

Examiner: _____

Date: _____